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| 09/692,155      | 10/20/2000  | Sandrine Decoster    | 05725.0793-00000    | 7711             |

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| EXAMINER |
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| ART UNIT | PAPER NUMBER |
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1617

DATE MAILED: 10/22/2003

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Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Application No.

09/692,155

Applicant(s)

DECOSTER ET AL.

Examiner

Gina C. Yu

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 30 June 2003.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-71,73,74,81-92,94 and 95 is/are pending in the application.
- 4a) Of the above claim(s) 86-92 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-71,73,74,81-85, 94 and 95 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

**Priority under 35 U.S.C. §§ 119 and 120**

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

**Attachment(s)**

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)                  | 4) <input type="checkbox"/> Interview Summary (PTO-413) Paper No(s). _____  |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)         | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____ | 6) <input type="checkbox"/> Other: _____                                    |

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**DETAILED ACTION**

Receipt is acknowledged of Amendment filed on June 30, 2003. Claims 1-71, 73, 74, 81-92, 94, and 95 are pending, and claims 1-71, 73, 74, 81-85, 94, and 95 are examined on the merits. Claims 86-92 have been withdrawn from consideration.

The claim rejection made under 35 U.S.C. § 103 (a) over Glenn et al. (US 5885948) ("Glenn") in view of Dalle et al. (EP 0874017) ("Dalle") as indicated in the previous Office action dated February 28, 2003 is withdrawn in view of applicants' amendment. The claim rejection made under 35 U.S.C. § 103 (a) over Glenn and Dalle and further in view of Dubief et al. (US 5690920) in the same Office action is withdrawn in view of applicants' amendment. New rejections are made. The claim rejection made under 35 U.S.C. § 103 (a) over Iwao et al. (US 4183917) ("Iwao") in view of Dalle is maintained for the reasons as indicated in the Office action dated February 28, 2003, but modified to meet the claim amendment. The claim rejection made under 35 U.S.C. § 103 (a) over Iwao and Dalle, and further in view of Restle et al. (US 6039936) ("Restle") is maintained for the reasons as indicated in the same Office action, but modified to meet the claim amendment.

***Claim Rejections - 35 USC § 103***

The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

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1. Claims 1-16, 44-47, 56, 73, 74, 81-85, 94, 95 are rejected under 35 U.S.C. 103(a) as being unpatentable over Dalle et al. (EP 0874017) ("Dalle") in view of Groh (US 5863943).

Dalle et al. teach a method of making silicone in water emulsions comprising at least one silicone compound that reacts with the polysiloxane of formula (I) in claim 1 by chain extension reaction, and at least one surfactant among anionic, nonionic, amphoteric, and cationic surfactants. See p. 1, line 34 – p. 4, line 17. In the reference, 9 parts by weight of polysiloxane is used, which meets claims 13-14 in the instant application. See Examples 1-3 on p. 6. The particle size of the silicone copolymer is also in the range of 0.3 – 100  $\mu\text{m}$ , which meets claims 15-16. See p. 5, lines 35-41. Dalle teaches that the emulsions here can be used in cosmetic compositions including personal lotions and emulsions. See p. 5, lines 46 – 57. The reference further teaches that the silicone is "lubricious and will improve the properties" of the compositions.

Groh teaches a skin conditioning oil-in-water lotion. See col. 4, lines 10 – 36. See instant claims 1 and 73. The reference teaches that the non-aqueous phase of the emulsion comprises moisturizing or emollient elements such as polydecenes, polyisobutens, hydrogenated polyisobutenes, or the mixture thereof. See col. 2, lines 48 – 59. The reference also teaches using emollients other than traditional oils as all or part of the non-aqueous phase, wherein the emollients may be synthetic liquid silicone polymers. See col. 2, line 58 – col. 3, line 29. The reference also teaches using nonionic surfactants such as glyceryl

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stearate, steareth-21, -2, and cetearyl alcohol. See col. 3, line 52 – col. 4, line 9.

See Table 1, Inventive Composition. See instant claims 44-47 and 56.

Given the teaching of the application of the silicone copolymer of Dalle in personal care lotion compositions, it would have been obvious to one of ordinary skill in the art at the time the invention was made to have looked to the prior arts such as Groh because of an expectation of successfully producing a skin conditioning aqueous emulsion composition. The skilled artisan would have been motivated to add the traditional emollient oils such as polydecene because of an expectation of successfully producing a skin care composition with good emolliency property.

2. Claims 1-16, 44-71, 74, 81-84, 94, and 95 are rejected under 35 U.S.C. 103(a) as being unpatentable over Dalle in view of Dubief et al. (U.S. Pat. No. 5804207) ("Dubief").

While Dalle teaches that the invention is applicable in formulating emulsion and shampoo compositions, the reference fails to teach the oil and surfactants of instant claims.

Dubief teaches a cosmetic emulsion composition for cleansing hair. The reference teaches the surfactants of instant claims 44-69 and the amount to use them in a cosmetic composition are well known in the art. See col. 2, line 25 - 4, line 66; col. 5, lines 27 – 34. The Dubief reference also teaches using oil components. See col. 6, lines 24 – 31. See Examples. The formulation is said to have good washing properties and cosmetic properties such as softness,

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disentangling, and styling, and "non-runny and melting texture". See col. 2, lines 46-49.

Given the teaching of the application of the silicone copolymer of Dalle in emulsion or shampoo compositions, it would have been obvious to one of ordinary skill in the art at the time the invention was made to have looked to the prior arts such as Dubief because of an expectation of successfully producing an emulsion shampoo composition. The skilled artisan would have been motivated to add the well-known surfactants in the Dubief reference because of an expectation of successfully producing an emulsion shampoo composition with good washing and cosmetic properties, and good texture.

3. Claims 1-17, 25, 27, 44-46, 56, 70, 71, 73, 74, 81-84, 94, and 95 are rejected under 35 U.S.C. 103(a) as being unpatentable over Iwao et al. (US 4183917) ("Iwao") in view of Dalle.

Iwao teaches hair conditioner compositions comprising synthetic oils, such as alpha-olefin polymers. See col. 2, lines 23 – 43. See instant claim 1(A), 94, and 95. The reference further teaches adding quaternary ammonium salts such as distearyldimethylammonium chloride. See col. 2, lines 44 – 59; Table 2 and Examples. See also instant claims 17 (IV), 25, and 27. The reference also teaches to use nonionic surfactants such as polyoxyethylene stearylether. See col. 2, line 60 – col. 3, line 13. See instant claims 44-47, 56.

Iwao et al. fail to teach the silicone copolymer recited in the instant claims.

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Dalle, discussed above, teaches that the silicone emulsion is useful in formulating hair products such as hair conditioner, for providing conditioning benefits. See p. 5, lines 51-52.

It would have been obvious to one of ordinary skill in the art at the time the invention was made to have modified the composition of Iwao by adding the silicone copolymer emulsion as motivated by Dalle, because of the expectation of successfully producing hair conditioner composition which provide enhanced conditioning benefits to the hair.

4. Claims 18-24, 26, 28-43, 47-51, 60, and 65-69 are rejected under 35 U.S.C. 103(a) as being unpatentable over Iwao and Dalle as applied to claims 1-17, 25, 27, 44-46, 56, 70, 71, 73, 74, 81-84, 94, and 95 above, and further in view of Restle et al. (U.S. Pat. No. 6,039,936).

While Iwao and Dalle teach quaternary ammonium cationic surfactants, the combined references fail to teach all of the specific surfactants recited in the instant claims.

Restle teaches that the cited quaternary ammonium surfactants are well known in the art. See col. 3, line 4 – col. 6, line 38. The Restle invention is directed to cosmetic oil-in-water emulsions comprising nonionic amphiphilic lipids (silicone surfactants) and cationic amphiphilic lipids. See col. 1, lines 36 – 67. Examples 1 and 2 in the reference also teach employing 1.5 % of the disclosed cationic amphiphilic lipids. See instant claims 41-43. See col. 8, lines 21 – 24 and Example 5 for the application of the composition in personal care products and the surfactants used therein. See instant claims 44-51, 60, 65-84. The

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Restle reference also teaches the use of synthetic oils including synthetic essential oils, polyethers, and silicone oils. See col. 7, lines 1 – 17. The reference further teaches that the advantages of the compositions include an enhanced penetration of active cosmetic ingredients on hair, and glossy appearance without greasy feel and softness. See col. 1, lines 36-49.

It would have been obvious to one of ordinary skill in the art at the time of the invention to have modified the composition of the combined references by substituting the cationic surfactants there with the cationic amphiphilic lipids in Restle et al. because of the expectation to have produced compositions which would provide similar glossy appearance, and softness on the hair. The claimed process is viewed an obvious use of the prior art compositions.

### ***Response to Arguments***

Applicant's arguments with respect to claims 1-71, 73, 74, 81-92, 94, and 95 have been considered but are moot in view of the new ground(s) of rejection.

Applicants' arguments regarding the obviousness rejection made over Glenn in view of Dalle are moot in view of the new ground of rejection.

Applicants' arguments regarding the obviousness rejection made over Glenn and Dalle, and further in view of Dubief et al. (US 5690920) are moot in view of the new ground of rejection.

Regarding the rejection made over Iwao in view of Dalle, applicants argue that no motivation to modify Iwao by adding the Dalle silicone copolymer is shown. Examiner respectfully disagrees. Examiner views that the collective teachings of the references offer objective evidences that a skilled artisan would



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have been motivated to modify the prior arts to produce the present invention. On the other hand, applicants' argument that such modification would not have been necessarily desirable to the routineer is a mere conjecture and not supported by any objective evidence.

Furthermore, it is generally considered prima facie obvious to combine two compounds each of which is taught by the prior art to be useful for the same purpose, in order to form a composition which is to be used for the very same purpose. The idea for combining them flows logically from their having been used individually in the prior art. See In re Kerkhoven, 626 F.2d 848, 205 USPQ 1069 (CCPA 1980). As shown by the recited teachings, the instant claims define nothing more than the concomitant use of two conventional hair conditioning agents. It would follow that the recited claims define prima facie obvious subject matter.

Applicants' arguments against the rejection made over Iwao and Dalle, and further in view of Restle are unpersuasive for above reasons.

### ***Conclusion***

No claims are allowed.

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is

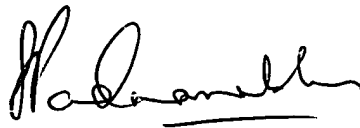
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filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Sreeni Padmanabhan can be reached on 703-305-1877. The fax phone numbers for the organization where this application or proceeding is assigned are 703-308-4242 for regular communications and 703-308-4242 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-1234.

Gina C. Yu  
Patent Examiner  
October 4, 2003

  
**SREENI PADMANABHAN**  
**SUPERVISORY PATENT EXAMINER**

05/20/03